

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

WILSON et al.

Serial No. 10/575,112

Filed: July 11, 2006

FOR: USE OF PHOTSENSITISATION

Confirmation No. 9398

Atty. Ref.: 117-581

T.C. / Art Unit: 1651

Examiner: S.R. Macauley

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PETITION UNDER 37 CFR § 1.144

January 28, 2010

Mail Stop Petition

Commissioner of Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Applicants petition the Director to invoke his supervisory authority and to review the Examiner's final requirement for an election of species. In accordance with M.P.E.P. § 1002.02(c), it is understood that authority to decide this petition may be delegated to a Technology Center Director. Applicants request mailing of an Office Action examining claims 6-7, which were withdrawn from consideration by the Examiner.

No fee is required for this petition. But if the Director asserts a fee is required or missing, authority is given to charge the fee to our Deposit Account No. 14-1140 under Order No. 117-581.

ISSUE IS RIPE FOR REVIEW

The Examiner required restriction of the claims in the Office Action mailed August 8, 2008. Applicants traversed the requirement in their response filed November 10, 2008. Claims 1-12 and 31 were elected. As regards the additional requirement for two elections of species, "(i) a staphylococcal bacteriophage (see claims 2 and 6-7) and (ii) a chlorin particularly SnCe6 (see claims 4-5)" were elected.

The restriction requirement was made final in the Office Action mailed March 2, 2009. Claims 6-7, 13-27 and 32-33 were withdrawn from consideration by the Examiner.

It is respectfully requested that the Director invoke his supervisory authority to review the Examiner's requirement and the election of staphylococcal bacteriophages. Here, at least phages 53, 75, 79, 80, 83, Φ11, Φ12, Φ13, Φ147, ΦMR11, 48, 71, Φ812, SK311, Φ131, SB-I, U16, C₁, SF370.1, SP24, SFL, and A1 (ATCC 12202-B1), which are listed in claims 6-7, are staphylococcal bacteriophages. Therefore, since the listed staphylococcal bacteriophages read on the elected species, claims 6-7 should have been examined in this patent application instead of being withdrawn from consideration.

This petition is timely because the restriction requirement was made final and an appeal has not yet been filed in this patent application.

STATEMENT OF FACTS AND POINTS TO BE REVIEWED

On August 8, 2008, the Examiner required an election of species:

“Election is required of the various species of bacteriophages recited in claims 2, 6 and 7. For example, applicant may elect a staphylococcal bacteriophage (recited in claim 1), phage 53 (recited in claim 6), or phage 75 (recited in claim 7).”

In response, Applicants elected “a staphylococcal bacteriophage (see claims 2 and 6-7)” (Response filed November 10, 2008 at page 6). Staphylococcal bacteriophage (also known as a staphylophage) is a subgenus of the bacteriophage recited in claim 1. Bacteriophages are viruses that infect bacteria by binding their surface and entering into the bacterial cell to express viral genes, often causing death of the bacteria by cell lysis. Thus, staphylococcal bacteriophages are bacteriophages that infect staphylococcal bacteria (e.g., *Staphylococcus aureus* and *S. epidermidis*).

There are many different specific staphylococcal bacteriophages that belong to the elected species. For example, many of those listed in claim 6 and both those listed in claim 7 are staphylococcal bacteriophages (see Table 1 at page 6 of Applicants' specification). Therefore, as claim limitations, bacteriophage is generic, staphylococcal bacteriophage is subgeneric, and phages 75 and Φ11 are specific.

The Office Action mailed March 2, 2009 acknowledged the election of species, but disagreed that claims 6-7 read on the elected species:

“[A]pplicant has stated that claims 2 and 6-7 read on the elected species of bacteriophages (applicant elected ‘staphylococcal bacteriophage’).

However, as stated in the office action mailed on August 8, 2008, election was required of one species of bacteriophage recited in claims 2, 6 and 7, such as staphylococcal bacteriophage (recited in claim 2), phage 53 (recited in claim 6), or phage 75 (recited in claim 7). Since only claim 2 reads on the elected species 'staphylococcal bacteriophage,' claims 6 and 7 have been withdrawn."

Therefore, claims 6-7 were withdrawn from consideration despite the facts that election of "staphylococcal bacteriophage" was invited by the Examiner and many bacteriophages listed in claims 6-7 are staphylococcal bacteriophages. Applicants protested in their response filed July 2, 2009 and requested that the Examiner correct the error:

"[The] specific bacteriophage listed in claims 6-7 are drawn to the elected elected species (i.e., a staphylococcal bacteriophage). Although only claim 2 recites staphylococcal bacteriophage, the withdrawn claims in fact do read on the elected species because the claims refer to specific types of staphylococcal bacteriophage. Thus, for example, phage 53 (recited in claim 6) and phage 75 (recited in claim 7) are both staphylococcal bacteriophage (see page 6, line 15, of the specification). Therefore, it is respectfully submitted that claims 6 and 7 should be examined in this application."

In Office Action mailed November 13, 2009, the Examiner replied to these arguments by stating, "Applicant elected 'staphylococcal bacteriophage,' therefore, claims not reciting the elected species have been withdraw."

Applicants disagree with the Examiner's conclusion because claims 6-7 do read on the elected species of staphylococcal bacteriophage. It is a fact that that at least phages 53, 75, 79, 80, 83, Φ 11, Φ 12, Φ 13, Φ 147, Φ MR11, 48, 71, Φ 812, SK311, Φ 131, SB-I, U16, C₁, SF370.1, SP24, SFL, and A1 (ATCC 12202-B1) are staphylococcal bacteriophages. This was stated in Table 1 at page 6 in Applicants' specification, which is taken as presumptively correct. See *In re Marzocchi*, 169 USPQ 367, 370 (C.C.P.A. 1971). The record contains no evidence to contradict or doubt this taxonomy. Therefore, a finding is requested that claims 6-7 read on the elected staphylococcal bacteriophage.

Applicants also disagree with the Examiner's withdrawal from consideration of claims 6-7. Claim 2 is not separately patentable from claims 6-7. For example, if all embodiments of the claimed invention having the bacteriophage limited to phage 75 or phage Φ 11 (i.e., claim 7) were obvious, then claims having the same limitations except that the bacteriophage is limited to a staphylococcal bacteriophage (see claim 2) would also be obvious. Similar arguments apply to the specific staphylococcal bacteriophages

(e.g., phages 53, 75, 79, 80, 83, Φ11, Φ12, Φ13, Φ147, ΦMR11, 48, 71, Φ812, SK311, Φ131, SB-I, U16, C₁, SF370.1, SP24, SFL, A1, and ATCC 12202-B1) listed in claim 6.

“Election of species should not be required between claimed species that are considered clearly patentable (obvious) over each other.” M.P.E.P. § 808.01(a). Here, this two-way test is not satisfied and withdrawal of claims 6-7 is not justified because, if a claim specific for “phage 75” were obvious, then the claim broadened to “staphylococcal bacteriophage” would be obvious too (of course, this does not necessarily apply to the converse because the limitation “phage 75” may confer patentability even if the limitation “staphylococcal bacteriophage” does not). Therefore, a finding is requested that an election of species between “staphylococcal bacteriophage” and the specific staphylococcal bacteriophages listed in claims 6-7 should not have been required.

ACTION REQUESTED

As discussed above, Applicants submit that claims 6-7 should not have been withdrawn after “staphylococcal bacteriophage” was elected in response to the Examiner’s requirement. Therefore, the Director is requested to invoke his supervisory authority over the Examiner and to direct: (i) the Office Action mailed November 13, 2009 be withdrawn, (ii) claims 6-7 be searched and examined, and (iii) a new Office Action be mailed. No serious burden prevents the examination of pending claims 1-12, 31 and 34-37. Alternatively, please consider this petition under 37 CFR § 1.182.

Applicants earnestly solicit grant of this petition. If any further information would assist in this decision, the Director or his designee is invited to contact the undersigned.

Respectfully submitted,

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